UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT C.U. YU,
ANTHONY M. HORGAN, SATCHIDANAND MISHRA,
DONALD C. VON HOENE, BING R. HSIEH,
EDWARD F. GRABOWSKI, RICHARD L. POST
and KATHLEEN M. CARMICHAEL

Appeal 2007-4506
Application 09/683,329
Technology Center 1700

Decided: October 23, 2007

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and THOMAS A. WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The record shows that we entered a Remand To The Examiner in Appeal No. 2005-2480 in this Application on October 27, 2005 (Panel Remand). In the Panel Remand, we stated a requirement for the Examiner and for Appellants:

> Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to interpret each of the appealed claims with respect to the terms and the relationship between the elements encompassed by the terms that we have discussed above, and further considering the ground of rejection with respect to the claims as interpreted, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.
>
> This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §1.41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

Panel Remand 6-7.

The Examiner mailed a Communication to Appellants styled "Response to Remand to Examiner" on December 20, 2005 (first Communication). In the first Communication, the Examiner responded to our first requirement to interpret certain claim language, and to further consider the ground of rejection.

Appellants responded to our second requirement by timely filing a Reply Brief on February 17, 2006 (second Reply Brief), in response to the Examiner's first Communication.

In the Communication mailed April 10, 2006 (second Communication), the Examiner refused entry of the second Reply Brief, stating:

> In response to the Remand by the Patent Board of Appeals and Interferences, the examiner provided a communication (mailed December 20, 2005) that clarified the description and scope of the claimed invention. A supplemental examiner's answer was not provided and as such, the reply brief submitted by applicant on February 17, 2006 has not been considered. As set forth in the MPEP 1208, a reply brief may be filed within 2 months from the date of the examiner's answer. In this instance, the examiner's answer was mailed on January 10, 2005.
>
> The application has been forwarded to the Board of Patent Appeals and Interferences for decision on appeal.

The Board entered an Order Returning Undocketed Appeal To Examiner on September 22, 2006 (first Order), stating:

> The letter mailed by the Examiner on December 20, 2005 is technically a Supplemental Examiner's Answer which would have been the proper course of action to take in responding to the Panel Remand issued by the BPAI. It is hereby ordered that the Examiner follow proper procedures and reformat the letter in accordance with 37 CFR § 41.50(a)(2) and issue a Supplemental Examiner's Answer. Further, in a letter mailed April 10, 2006, the Examiner denies entry of the Appellant's Reply Brief submitted and received by the Office on February 17, 2006, stating that it will not be considered because there was no Supplemental Examiner's Answer written, and that the Reply Brief is not timely. The Examiner is clearly in error. It is vital that the Examiner take corrective steps to rectify the above-mentioned errors.

The Examiner revised the Examiner's Answer mailed January 10, 2005 (first, by adding the contents of the first Communication thereto, and mailed the revised Answer on November 2, 2006 (second Answer). The

second Answer was still further revised with respect to a procedural matter and that revised Answer was mailed December 1, 2006 (third Answer).

The Board entered an Order Returning Undocketed Appeal To Examiner on May 17, 2007 (second Order), noting several deficiencies with the third Answer, specifically noting "[t]he first Order, issued September 22, 2006, required the Examiner to issue a corrected Examiner's Answer and consider a timely filed Reply Brief. The record does not reflect that the Examiner has considered the Reply Brief received February 17, 2006."

The Examiner mailed a revised Examiner's Answer on June 1, 2007 (fourth Answer). In the fourth Answer, the Examiner complied with the second Order to the extent of inserting a notice that the fourth Answer constitutes "a supplemental Examiner's Answer under 37 CFR 41.50(a)(2)" for "further consideration of a rejection" pursuant to the Panel Remand, and a notice to Appellants with respect to their response options under this rule provision. Fourth Answer 2 and 18-19 (original emphasis omitted).

The record shows the Board held the Examiner's first Communication to constitute a Supplemental Examiner's Answer and held Appellants' second Reply Brief under 37 C.F.R. § 41.50(a)(2)(ii) to have been timely filed with respect to the first Communication within the time period set forth in the rule. *See also* 37 C.F.R. § 41.41(a)(1). Thus, there is no requirement on Appellants to again file the second Reply Brief in response to the fourth Answer.

However, the Examiner has yet to consider the second Reply Brief under 37 C.F.R. § 41.43(a)(1), as pointed out in the first and second Orders.

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to consider the

second Reply Brief under 37 C.F.R. § 41.43(a)(1), with a view toward placing this Application in condition for decision on appeal with respect to the issues presented.

This remand is *not* made for the purpose of directing the examiner to further consider a ground of rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) (2005) does not apply.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

tc/ls

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